



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/108,715	07/01/1998	KOICHI NAGATA	05058/72201	2753

24367 7590 04/07/2003

SIDLEY AUSTIN BROWN & WOOD LLP  
717 NORTH HARWOOD  
SUITE 3400  
DALLAS, TX 75201

EXAMINER

GRANT II, JEROME

ART UNIT PAPER NUMBER

2624

DATE MAILED: 04/07/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/108,715

Applicant(s)

NAGATA, KOICHI

Examiner

Jerome Grant II

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2624

### Detailed Action

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon.

With respect to claim 1, Gordon teaches a facsimile apparatus (shown in figure 1) which is capable of receiving confidential image data (see cols. 11 and 12, from an origin and which is provided with a confidential reception function, comprising: a memory which stores received confidential image data (see mass memory 67 in figure 3); notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it.

Art Unit: 2624

Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see col. 11, lines 50-60. Note that a Notification is sent to the designee concerning the secure document. There is a notice to the original of the fax that messages have been delivered (but not retrieved yet) since the notification is prior to the user having a chance to retrieve the message. Gordon teaches wherein said notification is transmitted if the received confidential image data has not been retrieved from the memory within a predetermined period of time. This is the time after notification given to designee and time required to access the secured document.

With respect to claims 2, 12, and 14 see col. 12, lines 50-55.

With respect to claims 3 and 10, see col. 13, lines 48-57.

With respect to claim 4, the address information is the mailbox number.

With respect to claim 5, see col. 11, lines 50-60. The notification includes posting the report or delivery correspondence.

With respect to claim 6, see col. 8, lines 52-56.

With respect to claim 7, see col. 3, lines 50-53.

With respect to claim 9, see col. 13.

Art Unit: 2624

With respect to claim 11, Gordon teaches a facsimile apparatus provided with a confidential reception function, comprising: a memory 67 which stores received confidential image data; an output means (user at a remote terminal or key pad who has access to the user mailbox number) for outputting stored confidential image data from said memory in response to input of a password by an operator; a determination means (general service control 50) for determining whether confidential image data has been outputted by the output means within a predetermined time after reception of confidential image data; notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it. Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see col. 11, lines 50-60. Note that a Notification is sent to the designee concerning the secure document. There is a notice to the original of the fax that messages have been delivered (but not retrieved yet) since the notification is prior to the user having a chance to retrieve the message.. Gordon teaches wherein said notification is transmitted if the received confidential image data has

Art Unit: 2624

not been retried from the memory within a predetermined period of time. This is the time after notification given to designee and time required to access the secured document.

With respect to claim 13, Gordon teaches a managing method for managing a confidential received image in a facsimile apparatus, the facsimile apparatus being provided with a confidential reception function, the method comprising the steps of: receiving confidentially image data (SAFF 8 or 18) and storing the received image data in a memory 67 in the facsimile apparatus; destination SAFF for monitoring whether the stored confidential image data has been outputted within a predetermined time after reception of the confidential image data, via the outside user accessing the system with the correct mailbox number, transmitting notification (answer function of SAFF 18, see col. 13, lines 48-57) which indicates if output has not occurred, when outputting of the confidential image data has not occurred within the predetermined time; detecting proper completion of transmission of the notification (user SAFF 8 and 18) and deleting the confidential image data from the memory in response to a detection of the proper completion of transmission of the notification, see col. 11, lines 50-60.

Art Unit: 2624

With respect to claim 15, Gordon teaches a facsimile apparatus capable of receiving confidential image data from a source, the facsimile apparatus comprising: a memory 67 capable of storing received confidential image data; a notification transmitter file 90 adapted to transmit a notification to the source; a confirmation apparatus (SAFF 8 and 18) adapted to confirm receipt of the notification by the source; and a deleting apparatus adapted to delete stored confidential image data ( col. 11, lines 50-60); wherein the notification transmitter 90 transmits the notification after a predetermined time if the notification data transmission means (file 90) for transmitting notification to the origin indicating that the received confidential image data has not been retrieved from said memory (col. 8, lines 1-10 and col. 9, lines 35-40). See also cols. 11 and 13. Note that secure messages are held in a mailbox until the designee accesses it. Gordon teaches a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification by the notification data transmission means, see col. 11, lines 50-60.

Art Unit: 2624

**Examiner's Remarks**

With respect to applicant's remarks found at the bottom of page 3 and bridging page 4, applicant contends that Gordon does not teach a transmission of a status report indicating the image has not been retrieved from the memory.

The examiner respectfully disagrees. Col. 7, lines 29-31 teaches that incoming calls are stored in a Mass Storage Unit 67. Col. 7, lines 32-40 indicates that the security status of the document is ascertained. In other words, the document that has been received is determined to be a secured document or not. Col. 11, indicates the situation when there are too many messages in a queue. Lines 18-26 of col. 11, indicated that a queue report is sent to a destination fax. This queue report indicates all of the messages that awaits the destination fax. The messages that have been stored in the queue and have not been transmitted to the destination fax machine may be identified as such in the "Queue Report", see line 20. Hence, it is the un-transmitted messages that have not been retrieved from the memory which may be transmitted when the un-transmitted messages are advanced ahead of the existing queue priority. Now that the un-transmitted messages are ahead of the queue, the messages are queued for transmission to the destination fax machine. Queue



Art Unit: 2624

reports and status reports notify the operator if messages that could be secured have been transmitted or not.

Applicant further argues in the first full paragraph of page 4, that Gordon does not provide deleting the confidential image data from the memory in response to a completion of the transmission of notification. The examiner strongly disagrees. The deletion of confidential information is taught clearly at col. 11, lines 50-60. The examiner is careful to note that Applicant has not commented on this portion of the Gordon reference relied upon by the examiner.

At the bottom of page 4 of the Applicant's remarks, Applicant reiterates the argument presented with regard to claim 1. In response, thereto, the examiner contends the limitation has been addressed above and is clearly taught by Gordon.

At page 5, Applicant contends that claim 13 is distinguished over Gordon in that it does not teach notification that output has not occurred when the confidential message has not been output in a predetermined time frame. The examiner strongly disagrees with this assertion, and notes that

Art Unit: 2624

applicant has not provided any proof to this assertion in connection with the sections of Gordon relied upon in the examiner's rejection to this claim.

At page 5, applicant contends that claim 15 is distinguished over Gordon in that it does not teach a status message back to the originator when the fax message is received by the SAFF system. The examiner strongly disagrees with applicant's contention. The features have been thoroughly explained in the rejection to claim 15. Applicant has not set forth any proof in support of his contention, and has not shown how the cols. and line numbers relied upon does not meet the claimed features.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 2624

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II

April 2, 2003